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EXAMINER

HANDY, DWAYNE K

ART UNIT PAPER NUMBER

1743

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/698,289

Applicant(s)

INOUE ET AL.

Examiner

Dwayne K. Handy

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 5 recites an “automated synthesis machine”, but does not provide any structure for the synthesis machine. The only elements claimed are for the control system – not the synthesis device.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 3-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Inoue (6,740,296). **This rejection remains in effect.**

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

The Examiner notes that applicant has included a footnote on page 7 of the Arguments (submitted 7/25/2005) that includes a statement that the "Inoue reference is assigned to Shimadzu which is the same assignee of the present application..." This is insufficient to overcome this rejection. While a declaration of affidavit is NOT required, a statement that the application and the reference were, **at the time the invention was made**, owned by, or subject to an obligation of assignment to the same person or entity. Assignment records or a mere statement of common ownership without the required statement (in bold above) are not sufficient evidence. Therefore, this rejection remains in effect.

5. Claim 6 is rejected under 35 U.S.C. 102(e) as being anticipated by Wang et al. (6,489,168). The Examiner believes applicant is familiar with the Wang reference. The previous Examiner had applied the reference under 103(a), but the Examiner is making a new rejection with this reference under 102(e).

Applicant has argued that Wang does not teach a data analysis module that picks out commands related to a vessel protocol. The Examiner respectfully disagrees.

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The Examiner redirects applicant to the same passage from Wang (column 6, lines 29-54) quoted by the previous Examiner (Office Action dated 3/24/2005, page 5):

Data analysis module 145 performs appropriate calculations on the sampled data (step 360), as will be discussed below, and the results are displayed on monitor 150 (step 370). Calculated results and/or sampled data can be stored in data storage 180 for later display and analysis. Reactor control system 100 determines whether the experiment is complete--for example, by determining whether the time for the experiment has elapsed (step 380). **Reactor control system 100 can also determine whether the reaction occurring in one or more of reactor vessels 210 has reached a specified conversion target based on results calculated in step 360; in that case, reactor control system 100 causes the addition of a quenching agent to the relevant reactor vessel or vessels as discussed above, terminating the reaction in that vessel.** For any remaining reactor vessels, reactor control system 100 samples additional data (step 330) and the cycle begins anew. When all reactor vessels 210 in reactor block 200 have reached a specified termination condition, the experiment is complete (step 390). The user can also cause the reaction to terminate by aborting the experiment at any time. It should be recognized that the steps illustrated in FIG. 3 are not necessarily performed in the order shown; instead, the operation of reactor control system 100 can be event driven, responding, for example, to user events, such as changes in reaction parameters, or system generated periodic events.

The Examiner also directs applicant to Figures 2C and 2D which clearly show that the data analysis module (145) is a part of the overall control system (100) that controls the reactors. In addition, the Examiner believes the quenching of a reaction based on reaching a specified conversion target (lines 39-42) meets the limitation of an operational protocol. Therefore, the Examiner fails to see how Wang does NOT teach a data analysis module that analyzes a protocol of commands and picks a command related to the selected reactor since the control system of Wang uses the calculations from the data analysis module to stop the reaction! The analysis module (145) is clearly part of the control system (100) that provides operational control of the reactors.

Based on this reading of Wang, the Examiner believes the reference to be applicable as a 102(e) reference.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 3, 4, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (6,489,168) in view of Borders (6,351,678). Wang teaches every element of claims 3, 4, 5 and 7 except for the display device showing selected vessels such that they can be identified on screen together with the operation contents of the selected vessels. Wang only displays information on the operations related to a selected vessel.

Borders teaches a control system for medical equipment. The control system is configured to provide a display menu of predefined configurations of a bed and then command the processor to move the bed components (Abstract). The display menus for controlling the bed are shown in Figures 9-14 and described in columns 9-11. In column 9, lines 33-52, Borders teaches that selection indicators (118, 120, 122, 124) are provided for navigating the menu(s) of the controller (40). Figures 10-12 show that once a selection is made from the menu of operations (again elements 118, 120, 122, 124 - adjust table, auto adjust table, adjust mattress, help info), the operation is identified at the top of the screen while the other menu selections remain at the bottom of the screen. This reminds the user which menu selection/operation the control system is focused on while still providing an icon for non-selected operations on that menu. It would have been obvious to one of ordinary skill in the art, then, to provide the selection indicator teaching from Borders with the control display of Wang. One would add the selection indicators to Wang in order to remind the user which function of the control system the user is examining or using.

### ***Response to Arguments***

8. Applicant's arguments, filed 7/25/2005 with respect to the rejection(s) of claim(s) 3, 4, 5 and 7 under Wang (103 rejection) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. The Examiner agrees with applicant that Wang does not teach a display device showing selected vessels such that they can be identified on screen together with the operation contents of the selected

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vessels. However, upon further consideration, a new ground(s) of rejection is made in view of Wang and Borders.

In addition to the new 103 rejection, the Examiner has made a new rejection of claim 6 using the Wang reference.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Togneri (3,533,764), Bullock et al. (3,391,275), Williamson, Jr. et al. (4,303,973) and Kuwamoto et al. (5,353,399) teach control systems.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
September 28, 2005

  
Jill Varden  
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